

PATENT

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

#9

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
Filed : December 15, 2000
For : A AXIS TRACKER

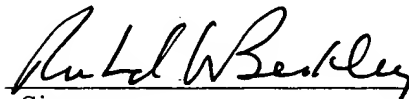
RENEWED PETITION UNDER 37 C.F.R. 1.47(b)

I hereby certify that this paper is being deposited
with the United States Postal Service as first class mail in
an envelope addressed to: Assistant Commissioner for
Patents, Washington, D.C. 20231

January 23, 2003
Date of Deposit

Richard G. Berkley
Attorney Name

25,465
PTO Registration No


Signature

January 23, 2003
Date of Signature

Attention: PCT Legal Office

Assistant Commissioner for Patents
Box PCT
Washington, D.C. 20231

Sir:

This is in response to the Decision on Petition Under 37 C.F.R. 1.47(b) dated
December 24, 2002 in the above-identified application.

PATENT

Applicant's renewed petition under 37 C.F.R. 1.47(b) was dismissed, without prejudice, on the ground that "[t]here is no evidence that the US application papers forwarded to Van Saarloos [the non-signing inventor] included a complete copy of the application including copies of the specification, claims, and drawings in addition to declaration and power of attorney and assignment papers." (Decision, p. 2). We respectfully disagree and invite the attention of the Office to the Statement of Facts in Support of Filing on Behalf of Nonsigning Inventor by Mr. Gregory Joseph Noonan dated June 7, 2002, and to Exhibit 1 to that Statement in particular. (For convenience of reference, courtesy copies of Mr. Noonan's June 7th Statement and Exhibits 1 and 2 thereto are enclosed herewith.)

Exhibit 1 to Mr. Noonan's June 7th Statement of Facts is a copy of a letter dated May 21, 2002, that Mr. Noonan sent via registered mail to Dr. Van Saarloos' Australian attorney, requesting that Dr. Van Saarloos execute two papers enclosed therewith in connection with United States patent application Serial No. 09/719,726. (Statement, ¶ 7) The letter identifies the two enclosed papers as:

- "1. Assignment
2. Combined Declaration and Power of Attorney with attached specification, claims and drawings". (Emphasis added)

Receipt by Dr. Van Saarloos' attorney of Mr. Noonan's May 21, 2002 letter and the enclosures thereto is evidenced by the registered mail receipt, dated May 23, 2002, and by an email acknowledgment, also dated May 23, 2002, from Dr. Van Saarloos' attorney, copies of both of which are appended as Exhibit 2 to Mr. Noonan's June 7th Statement of Facts.

The evidence of record, therefore, clearly shows that the U.S. application papers forwarded to Dr. Van Saarloos' attorney for signature did, in fact, include a complete copy of the

PATENT

application, including copies of the specification, claims, and drawings in addition to declaration and power of attorney and assignment papers. It is noted that the Decision refusing applicant's original petition, dated December 10, 2001, specifically provides that evidence of the submission of the complete U.S. application to the nonsigning inventor's attorney is sufficient. (Decision, p. 4)

In a telephone conference on January 10, 2003 with Mr. Neas of the PCT Legal Office, applicant's attorney advised Mr. Neas of the foregoing record evidence of the submission of the complete U.S. application to Dr. Van Saarloos' attorney. Upon consideration of such evidence, Mr. Neas advised applicant's attorney in a subsequent telephone call on January 10, 2003, that the record evidence is sufficient to show submission of the complete application to Dr. Van Saarloos. Mr. Neas requested, however, that the applicant submit a statement confirming that, to date, Dr. Van Saarloos had still not signed the application papers.

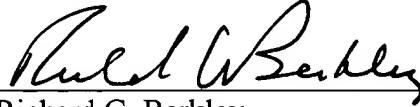
Enclosed herewith is a further Statement of Facts in Support of Filing on Behalf of Non-signing Inventor by Mr. Noonan, dated January 20, 2003. In Paragraph 2 of the January 20th Statement of Facts, Mr. Noonan confirms that a complete copy of the United States application, including the declaration, power of attorney, specification, claims, and drawings, was submitted to Dr. Van Saarloos' attorney along with Mr. Noonan's letter of May 21, 2002, Exhibit 1 to Mr. Noonan's earlier Statement of Facts. In Paragraph 3 of the January 20th Statement of Facts, Mr. Noonan states that, to date, Dr. Van Saarloos has not returned a signed declaration and power of attorney either to him or, based upon information from an officer of The Lions Eye Institute, to The Lions Eye Institute.

In view of the foregoing, we respectfully request that applicant's Rule 147(b) petition be reconsidered on the merits and granted.

PATENT

The Commissioner is hereby authorized to charge any fees which may be required, or credit any overpayment, to Deposit Account Number 02-4377.

Respectfully submitted,

A handwritten signature in cursive script, appearing to read "Richard G. Berkley", is written over a horizontal line.

Richard G. Berkley
PTO Reg. No. 25,465
Attorney for Applicant
(212) 408-2554

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
Filed : December 15, 2000
For : "Z Axis Tracker"

STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. §1.47(b))

I, Gregory Joseph Noonan, residing at 18 Somers Avenue, Malvern, Victoria, 3144, Australia, state:

1. I am a registered patent attorney in Australia, and a partner of Freehills Carter Smith Beadle (patent and trade mark attorneys), of 101 Collins Street, Melbourne, Victoria, Australia.

2. I was appointed by The Lions Eye Institute of Western Australia Incorporated, [the Institute] in early 1999, to handle a number of its patent application files. On behalf of the Institute I arranged the filing of international patent application PCT/AU99/00479, on 17 June 1999. Subsequently, I arranged, through US patent attorneys, the filing of the counterpart US national phase application, assigned the serial number 09/719,726.

3. I have reviewed the Statement of Facts in these proceedings by Ian Jeffrey Constable dated 27 July 2001 and in particular exhibits 1 and 7. I have further reviewed my files and discussed the matter with Jeanette Butler, who is mentioned in the aforesaid Statement of Facts dated 27 July 2001. We have agreed that it is uncertain as to whether the US application papers forwarded to Dr Paul Van Saarloos for signature in connection with US patent application 09/719,726 were accompanied by a copy of the specification, claims and drawings.

4. However, I am aware that Dr Van Saarloos was fully informed and knowledgeable as to the content of US patent application 09/719,726. During the period from early 1999 to about May 2000, Dr Van Saarloos was the officer of the Institute responsible for managing the Institute's patent matters that I was handling and so he generally reviewed and had significant input to draft patent applications and proposed amendments.

5. I have examined my files in connection with international patent application PCT/AU99/00479 and find that Dr Van Saarloos reviewed the draft specification sent to him in June 1999, and commented in detail with a number of suggested amendments. The international application was not amended during the international phase.

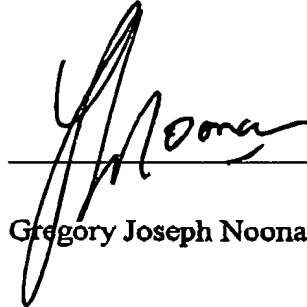
6. It is therefore clear to me that, at the times he was forwarded the US application papers for signature, Dr Van Saarloos was familiar with the content of the international patent application and therefore also of the US national phase application. The US application papers did not refer to the specification as being attached.

7. On 21 May 2002, I wrote to Mr Mark Dwyer, of Corrs Chambers Westgarth, Dr Van Saarloos' lawyers, requesting Dr Van Saarloos' signature on an assignment and a combined declaration and power of attorney ("the forms"). A copy of this letter is appended as Exhibit 1. Copies of the registered mail receipt and an email acknowledgment from Mr Dwyer are appended as Exhibit 2. I wrote to Mr Dwyer because legal proceedings between the parties are continuing.

8. Mr Dwyer called me on 6 June 2002, in response to three earlier telephone calls from me, and informed me that (i) he had promptly sent the forms to Dr Van Saarloos and Dr Van Saarloos had confirmed receipt, (ii) Dr Van Saarloos left for the United States a few days ago with the forms in his possession and would not return to Australia until later this month, and (iii) Dr Van Saarloos was not refusing absolutely to sign the form but had refused to sign and return the form before his departure.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of the application or my patent issued thereon.

Date:

7 June 2002

Gregory Joseph Noonan

Freehills

Carter Smith Beadle

Exhibit 1

21 May 2002

Our ref M40463811:GJN:JLM
Phone (03)9288 1578
Email greg_noonan@freehills.com.au

Doc no Melbourne004055601

Mr Mark Dwyer
Corrs Chambers Westgarth
GPO Box 9925
PERTH WA 6001

By Registered Mail

Dear Mr Dwyer

The Lions Eye Institute of Western Australia Incorporated
United States patent application no. 09/719726
Z axis tracker

We are patent attorneys acting for The Lions Eye Institute of Western Australia Incorporated in relation to this matter.

On several occasions during 2001, you and your client Dr Paul Van Saarloos were asked for Dr Van Saarloos' signature on papers connected with the above-referenced patent application.

We now attach copies of the following two papers and ask again that Dr Van Saarloos sign the documents where tagged and return them to us by Monday 3 June 2002 at the latest. We must file paper (2) in the US Patent Office by 10 June 2002.

- 1 Assignment
- 2 Combined Declaration and Power of Attorney with attached specification, claims and drawings.

A lack of response from you by 3 June 2002 will be taken to constitute a refusal by Dr Van Saarloos to sign paper (2) above.

If Dr Van Saarloos' present concern is confined to paper (1), we will be pleased to receive paper (2) only by 3 June 2002. This will ensure ongoing regularisation of the US application. The assignment can be filed later.

If you or Dr Van Saarloos have any questions concerning these documents, please do not hesitate to call.

Yours faithfully
Freehills Carter Smith Beadle

Greg Noonan
Partner

Enc.

Patent & Trade Mark Attorneys

101 Collins Street Melbourne Vic 3000 Australia Telephone 61 3 9288 1577 Facsimile 61 3 9288 1667
GPO Box 128A Melbourne Vic 3001 Australia www.fcsb.com.au

Offices in SYDNEY MELBOURNE Registered Patent Attorneys in Australia & New Zealand

Exhibit 2



Mark_Dwyer@corrs.com.au cc:

To: Greg_noonan@freehills.com.au

23/05/2002 14:08

Subject: LEI - Z axis tracker

US

40463811

Dear Sir,

We have received your letter to us dated 21 May 2002 together with the enclosures.

We will obtain our client's instructions and revert to you as soon as possible.

Regards.

This e-mail and any attachments may be confidential. You must not disclose or use the information contained in this e-mail if you are not the intended recipient. If you have received this e-mail in error, please notify us immediately and delete the e-mail and all copies. Corrs does not guarantee that this e-mail is virus or error free. The attached files are provided and may only be used on the basis that the user assumes all responsibility for any loss, damage or consequence resulting directly or indirectly from the use of the attached files, whether caused by the negligence of the sender or not. Corrs is not responsible for any changes made to a document other than those made by Corrs, or for the effect of any changes (not made by Corrs) on a document's meaning. The content and opinions in non-business e-mail are not necessarily those of Corrs.

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Signature of Delivery Officer

Date delivered

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IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

Applicant : Paul Phillip Van Saarloos
Serial No. : 09/719,726
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STATEMENT OF FACTS IN SUPPORT OF FILING
ON BEHALF OF NONSIGNING INVENTOR (37 C.F.R. §1.47(b))

I, Gregory Joseph Noonan, residing at 18 Somers Avenue, Malvern, Victoria, 3144,
Australia, state:

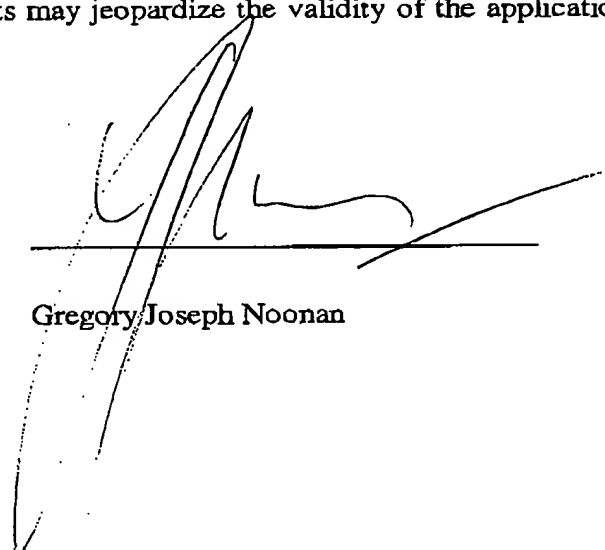
1. I am a registered patent attorney in Australia, and a partner of Freehills Carter Smith Beadle (patent and trade mark attorneys), of 101 Collins Street, Melbourne, Victoria, Australia.

2. I made an earlier Statement of Facts in these proceedings dated 7 June 2002. In that Statement, at paragraph 7, I referred to my letter of 21 May 2002 to Dr Van Saarloos' lawyers, requesting Dr Van Saarloos' signature on an assignment and a combined declaration and power of attorney. As evident from the appended copy of the letter, the Combination Declaration and Power of Attorney was accompanied by an attached specification, claims and drawings.

3. To date, Dr Van Saarloos has not returned a signed combined declaration and power of attorney to either me or The Lions Eye Institute of Western Australia Incorporated. I enquired of an officer of The Lions Eye Institute of Western Australia Incorporated, by email on 17 January 2003, and she has also confirmed that The Lions Eye Institute of Western Australia Incorporated has not received a signed combined declaration and power of attorney.

I hereby declare that all statements made herein of my own knowledge are true and that all statements made on information and belief are believed to be true; and further that these statements were made with the knowledge that wilful false statements and the like so made are punishable by fine or imprisonment, or both, under Section 1001 of Title 18 of the United States Code and that such wilful false statements may jeopardize the validity of the application or my patent issued thereon.

Date: 20 Jan 2003



Gregory Joseph Noonan